

REMARKS

The Office Action mailed September 4, 2008, and the prior art newly cited and applied therein have been carefully studied. The claims in the application are now claims 1, 4, 6 and 8-28, the features of the dependent portions of claims 2, 3, 5 and 7 having been incorporated above into claim 1. Applicants' claims define novel and unobvious subject matter under Sections 102 and 103, and therefore should be allowed. Favorable reconsideration and allowance are therefore respectfully requested.

Claims 9, 10 and 12 have been rejected under the second paragraph of Section 112 as indefinite. The rejection is respectfully traversed.

Appropriate amendments have been made in claims 9 and 12, and it is believed that they are clear. Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-3, 7, 13-16, 19 and 20 have been rejection under Section 102 as anticipated by Akao USP 4,469,741 (Akao '741). This rejection is respectfully traversed.

It is noted that claim 5 has not been so rejected. The feature of the dependent portion of claim 5 now being incorporated into claim 1, applicants understand that this

rejection is not deemed applicable by the PTO against claim 1 and the claims which depend therefrom, in their present form, whereby this rejection need not be further addressed at the present time.

Withdrawal of the rejection is respectfully requested.

Claims 4, 5, 8, 11, 12, 18 and 21-28 have been rejected under Section 103 as obvious from Akao '741. This rejection is respectfully traversed.

First, original claim 7, now incorporated into claim 1, calls for a dot ratio of 5 to 70%. Such subject matter is not disclosed in Akao '741.

In the rejection under Section 102, at page 4, it is stated that "it is inherent [in Akao '741] for the light shielding layer... to have a dot ratio of from 5-70%." Applicants respectfully disagree, as that subject matter is neither inherent nor obvious.

Akao '741 is directed to a laminate sheet which, according to what is stated in the Akao abstract and elsewhere, "makes it suitable for use as a wrapping material for light-sensitive materials."

Following example 2, and at the top of column 7, at lines 7-11, Akao '741 states as follows:

For example, incorporation of such light-shielding substances into wrapping materials of light-sensitive materials produces an excellent effect that could not be obtained by conventional wrapping materials.

It is absolutely clear that in order to protect light-sensitive materials from light, the shielding must be substantially total, i.e. the photosensitive materials to be protected according to Akao '741 must be strictly protected from light exposure. If the photosensitive materials to be protected by Akao '741 were in a package made of material having a dot ratio of 5-70%, they would be easily exposed to light, and therefore Akao '741 does not provide the claimed dot ratio, and indeed **teaches away from** what is claimed.

For the PTO to properly rely on inherency, the inherency must be "reasonably certain." In the present case, there is not only no reasonable certainty, but to the contrary it is reasonably certain that the laminated sheets of Akao '741 do not have a dot ratio from 5 to 70% as claimed.

Further, and for the record, applicants also do not agree with, and therefore must respectfully traverse, other conclusions reached in the rejection which are respectfully submitted to be erroneous. For example, in the top paragraph on page 6 of the Office Action, it is erroneously assumed that the parameters recited are basically unimportant, relate to aesthetics rather than function, and are only optimum

parameters involving simply routine skill to achieve. However, it has been pointed out above that Akao '741 has a different objective which produces a result different in kind from that according to the present invention.

It therefore could not have been obvious to the person of ordinary skill in the art at the time the present invention was made to change the parameters required according to Akao '741 to provide a product which would destroy Akao '741 for its intended purpose, i.e. not achieve protection of the photosensitive materials within the package.

Applicants' claimed subject matter would not have been obvious from Akao '741. Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-3, 6, 7, 13-17, 19 and 20 have been rejected under Section 102 as anticipated by Akao USP 4,653,640 (Akao '640). This rejection is respectfully traversed.

Claim 5 has not been included in this rejection. As the subject matter of claim 5 has been incorporated into claim 1, applicants understand that this rejection is deemed by the PTO to be not applicable against claim 1 in its present form, whereby applicants need not address this rejection at the present time.

Withdrawal of the rejection is respectfully requested.

Claims 4, 5, 8-12, 18 and 21-28 are rejected as obvious under Section 103 from Akao '640. This rejection is respectfully traversed.

Akao '640 like Akao '741 has the objective of making "a laminate suitable for packing... (photographic) photosensitive materials..." See also and especially Akao '640 commencing at about the middle of column 17 under the heading "EFFECT OF THE INVENTION".

As with Akao '741 as discussed above, it would not have been obvious to so modify Akao '640 so as to destroy Akao '640 for its intended function.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-3, 6, 7, 13, 14, 19 and 20 have been rejected under Section 102 as anticipated by Akao USP 4,661,401 (Akao '401). This rejection is respectfully traversed.

Again, claim 5 has not been rejected as anticipated by Akao '401, and so applicants understand that this rejection

would not be deemed applicable against claim 1 in its present form, and of course the claims dependent therefrom.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 4, 5, 8, 11, 12, 18 and 21-28 have been rejected as obvious under Section 103 from Akao '401. This rejection is respectfully traversed.

Akao '401 is directed to a laminated film comprising a foamed core for use as "light shielding... suitable for packaging photosensitive materials", similar to the other two aforementioned Akao patents. As pointed out above, it is neither inherent in Akao '401 nor obvious from Akao '401 to do what applicants have claimed, namely to permit the passage therethrough of light, which would destroy Akao '401 for its intended function.

Withdrawal of the rejection is in order and is respectfully requested.

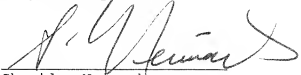
Again, the prior art documents of record and not relied upon have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

Applicants believe and respectfully submit that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable reconsideration and allowance are respectfully requested.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By


Sheridan Neimark
Registration No. 20,520

SN:jnj
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\JN\5\SIKS\NITTA1\PTO\2009-1-5AMDPT.doc